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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,928	06/15/2001	Joachim Horsch	018483-0710	5729

7590

07/03/2002

Foley & Lardner  
Firststar Center  
777 East Wisconsin Avenue  
Milwaukee, WI 53202-5367

EXAMINER
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PETRAVICK, MEREDITH C

ART UNIT	PAPER NUMBER
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3671

DATE MAILED: 07/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/882,928

Applicant(s)

HORSCH, JOACHIM

Examiner

Meredith C Petravick

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/15/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

## DETAILED ACTION

### *Reissue Applications*

1. Claims 29-39 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The claims of the reissue application are broader than the claims of the original patent. Claims 29 and 35 of the reissue application are claiming a combination of a combine with a rotator and a transmission. The transmission includes: an engine, a hydraulic pump, a hydraulic motor, and an electronic control circuit for maintaining the rotor at a selected speed. Claim 16 of the original patent claims the combination a threshing system for a combine including a clutch assembly and a differential assembly in lines 8-12 that has an output coupled to a threshing rotor.

The claims of the reissue application are missing the limitations of a differential assembly found in the original claim 16, lines 8-12 and a clutch assembly found in the claims of the original application.

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The Reasons for Allowance, paper # 4 of the parent application, specifically cites “a differential with one input coupled to the output of a clutch assembly, the other input coupled to a hydrostatic transmission, a threshing rotor coupled to the differential output [claims 16 and 30].” Applicant did not comment on the Reasons for Allowance in the original patent application.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 33-34 and 38-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 33 recites the limitation "the appropriate control signals" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 38 recites the limitation "the appropriate control signals" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 29-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitt et al. 3,093,946 in view of Wieneke et al. 3,606,742.

Pitt et al. discloses a combine including:

- a threshing rotor (15)
- an engine (11)
- a hydraulic pump (10) driven by the engine
- a hydraulic motor (14) driven by the pump and driving the rotor

The engine drives the hydraulic pump which drives the hydraulic motor which drives the rotor. The transmission maintains the set rotor speed (Column 4, lines 14-24). The rotor speed is set manually by the operator moving the lever (49) that controls the pump (Column 6, lines 19-22). The Pitt et al. fails to disclose providing an electronic control circuit for automatically setting the rotor speed instead of manually setting the speed with a lever.

Like Pitt et al., Wieneke et al. discloses a combine with a threshing rotor. Wieneke et al. teaches that it is desirable to provide a combine with an electronic control system that automatically adjusts the speed of the rotor in response to sensed conditions, including the speed of the threshing rotor (Column 2, lines 35-42). This allows the rotor speed to be adjusted to optimally thresh the crop that is inside the combine at that time.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the combine of Pitt et al. with an electronic control system for controlling and maintaining the threshing rotor speed instead of a manual lever as taught in Wieneke et al., in order to optimally threshing the crop by matching the rotor speed to the characteristics of the crop when it is in combine.

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In regards to claim 30-31 and 36-37, the rotor in Pitt et al. is a threshing rotor.

In regards to claim 32, the hydraulic pump in Pitt et al. is electronically controlled and the displacement is variable.

***Conclusion***


6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meredith Petravick whose telephone number is 703-305-0047.

The examiner can normally be reached on Monday-Thursday from 7:00 a.m. – 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached at 703-308-3870.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is 703-305-1113. The fax number for this Group is 703-305-3597.

  
**Thomas B. Will**  
**Supervisory Patent Examiner**  
**Group Art Unit 3671**

MCP  
June 25, 2002